

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board .

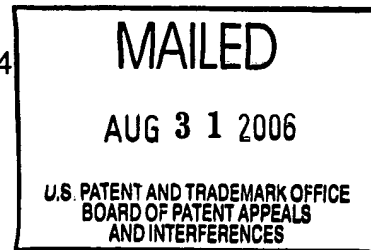
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY MORGAN ALDEN and DANIEL J. REAUME

Appeal No. 2006-1833
Application No. 09/740,584

ON BRIEF



Before THOMAS, BLANKENSHIP, and HOMERE, **Administrative Patent Judges.**

HOMERE, **Administrative Patent Judge.**

REMAND TO EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 19, in accordance with 37 CFR § 41.50(a)(1). After considering the record before us, we are convinced that the instant appeal is not ready for a meaningful review. Accordingly, we hereby remand the application to the Examiner to consider the following issues, and to take appropriate action.

BACKGROUND

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of analyzing a sub-model of a full system model, said system model representing a system, said method comprising the steps of:

defining the sub-model as a collection of entities in a visual medium;

determining which of the entities in the sub-model are calculation entities and which are data entities;

converting the calculation entities in the sub-model that depend on entities in the full model that are not included in the sub-model into temporary data entities;

identifying output entities in the sub-model, where the output entities are calculation entities that do not have an output to another entity; and

visually analyzing changes in the sub-model in response to performing the calculations for the calculation entities, wherein visually analyzing changes in the sub-model includes analyzing changes in the size of at least one data entity.

Rejections at Issue

A. Claims 1 through 19 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. We refer herein to the Examiner's Answer (mailed on December 1, 2005).

REASONS FOR REMAND

The Examiner's statement of the rejection of claims 1 through 19, at page 4 of the Examiner's Answer, alleges that the claims are directed to a process for manipulating an abstract idea. Particularly, the Examiner alleges that visually analyzing changes in the sub-model including analyzing changes in size of at least one data entity, as recited in the claims, is not a practical application that produces a useful, concrete and tangible result. Then, at page 5 of the Examiner's Answer, the Examiner looks to MPEP 2106 for guidance to establish a prima facie case for the non-statutory rejection. Consequently, the Examiner asserts that the claims are not statutory because they are not directed to a practical application in the technological arts.

We note that the Examiner's statement of the rejection correctly sets out the test for determining patent subject matter eligibility. In other words, under current patent law, if a claim is directed to a practical application of a judicial exception (abstract idea, law of nature, natural phenomenon) of 35 U.S.C. 101, it must produce a useful, concrete and tangible result to be statutory. See **State Street Bank & Trust Co. v. Signature Financial Group Inc.**, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). See also **AT&T Corp. v. Excel Communications Inc.**, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). We note, however, that the Examiner's reliance on MPEP 2106 for guidance to support his prima facie case of non-statutory subject matter under 35 U.S.C. §

101 is misplaced. There is no basis in patent law for the technological arts requirement. The Board of Patent Appeals and Interferences rejected such a requirement in Ex Parte Lundgren.¹ The Examiner therefore is advised to look to the interim examination guidelines ("Guidelines") for guidance necessary to properly evaluate the claims before a prima facie case under 35 U.S.C. § 101 can be properly established.² If the Examiner wishes to maintain the instant rejection, the Examiner must accordingly provide a supplemental Examiner's Answer in which the Examiner correctly applies the proper requirements, as prescribed under current patent law.

CONCLUSION

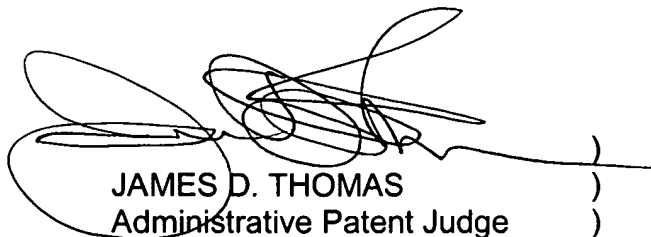
This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental Examiner's Answer is written in response to this remand by the Board.

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01 (8th ed., Rev. 3, August 2005). It is important that the Board be informed promptly of any action affecting the appeal in this case.

¹ Appeal No. 2003-2088, Application 08/093,516 (Precedential BPAI opinion September 2005). See also Guidelines, *infra* note 2, at 42-45, ANNEX III (stating that US patent law does not support the application of a "technical aspect" or "technological arts" requirement.)

² Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," 1300 Off. Gaz. Pat. And TM Office, 1300 OG 142, No. 4, page 4 (November 22, 2005)(stating

REMANDED


JAMES D. THOMAS
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
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JEAN R. HOMERE
Administrative Patent Judge

JH/gw

that "USPTO personnel are to rely on these Guidelines in the event of any inconsistent treatment of issues between these Guidelines and any earlier provided guidance from the USPTO).

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